

### **REMARKS**

Reconsideration of this application, as presently amended, is respectfully requested. Claims 1-20 are pending in this application, new claims 19-20 having been added by the present Amendment. Claims 1-18 stand rejected.

#### **Claim Amendments to Correct Informalities**

Although the claims were not specifically objected to for informalities, the independent claims have been amended to correct minor informalities.

#### **Claim Rejections-35 U.S.C. §103**

Claims 1, 3, 4, 6, 7, 9, 10, 12, 13, 15, 16 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Johnson et al.** (USP 6,580,950) in view of **Pearce** (USP 5,675,814). Claims 2, 5, 8, 11, 14 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Johnson et al.** and **Pearce** in view of **Hilt** (USP 6,738,820). For the reasons set forth in detail below, these rejections are respectfully traversed.

Detailed patentability arguments are set forth below. In summary, according to the Examiner, **Pearce** teaches that one well-known way of achieving power conservation is shutting down parts of a computer which are not being used (column 1, lines 54-65). However, **Pearce** merely discloses shutting down display if the display screen has not been used more than a predetermined period of time (column 1, lines 59-61) and switching to a standby state if the hard disk storage media of the computer has not been accessed for more than a predetermined period



of time (column 1, lines 62-65). Therefore, **Pearce** does not teach a power control unit that changes the power mode from the normal power mode to the power-saving mode when the setting of the remote control data to the apparatus to be remote controlled is complete, as recited in claim 1 (and similarly in claims 4, 7, 10, 13 and 16 ). The invention of claim 1 (and similarly claims 4, 7, 10, 13 and 16) does not need to wait or monitor a predetermined time period). Therefore, the claimed invention has a simpler structure and is able to save more power than what is disclosed in **Pearce**.

As will be discussed in detail below, it is respectfully submitted that the Office Action has not established a *prima facie* case of obviousness under §103. More specifically, it is respectfully submitted that the a *prima facie* case of obviousness has not been established and, as such, the rejection of claims 1-18 should be withdrawn, because (1) all the claim limitations are not taught or suggested by the cited prior art; (2) proper motivation or incentive for combining the references has not been provided; and (3) all claim limitations have not been considered in rejecting the claims.

The Examiner relies on the **Johnson et al.** reference to teach the general features of a system that has a “gateway” allowing a user to monitor and/or control various features of their home from a distant location via a computer network. The Examiner relies on the **Pearce** reference to teach the claimed features relating to a power mode control unit.



**The Johnson et al. reference**

**Johnson et al.** discloses an Internet based home monitoring and control system allowing a homeowner to remotely monitor and control a control device, such as a heating controls and cameras (see col. 2, lines 13-19), by accessing a Web page using a conventional Web browser on a computer.

As shown in Figs. 1 and 2 of **Johnson et al.**, the Internet based home monitoring and control system includes a control unit 30 that is connected to a plurality of control devices 40 (e.g., lighting controls 42, heating controls 44, etc.), within a home. The control unit 30 is connected to a global computer network 12 (i.e., the Internet). The **Johnson et al.** system also includes a data center 20 having server computers connected to global computer network 12. The control unit 30 is in communication with a data center 20 via the global computer network 12. A homeowner is capable of monitoring and controlling the control devices 40 within the home by accessing a Web page displayed at the data center through a conventional web browser 14 on a computer 16. See, e.g., column 4, lines 16-53.

As described, e.g., in column 6, line 60 – column 7, line 4 of **Johnson et al.**, a homeowner can remotely control settings with a home by entering the settings into a computer 16, which transmits the settings to the control unit 30 via the data center 20. The control unit 30 transmits the setting data to the control devices 40.

The Examiner considers the control unit 30 to correspond to the claimed “gateway card connected to an information processor ...that receives and transmits data between different



networks.” Thus, **Johnson et al.** teaches a basic type of gateway to remotely monitor and control devices in a home.

The Examiner recognizes that the **Johnson et al.** reference does not disclose or suggest changing a power mode of an information processor from a power-saving mode to a normal mode when the receiving unit receives the remote control request, and changing the power mode from the normal mode to the power saving mode when the setting of the remote control data to the apparatus to be remote controlled is complete (see Office Action, sentence bridging pages 2 and 3). Applicants agree with the Examiner that **Johnson et al.** does not disclose or suggest the above-noted features of the power control unit. In fact, **Johnson et al.** is *completely silent regarding any power saving device or operation.*

#### **The Pearce reference**

The Examiner relies on the **Pearce** reference to teach the features missing from **Johnson et al.** Specifically, the Examiner asserts that **Pearce** discloses supplying power to an I/O port of a computer only when I/O operations requiring that I/O port are encountered (see Office Action, page 3, lines 2-6).

The Examiner concludes

“it would have been obvious to one of ordinary skill in the art to modify the **Johnson** system to operate the information processor in a power saving mode when no remote control requests requiring the information processor are received and operating the information processor in a normal mode when remote control requests requiring the information processor are received. Operating the information processor in the power-saving mode when it is not being used reduces unnecessary power



consumption [Pearce, column 1, lines 54-58].” See Office Action, page 3, lines 6-11.

**Pearce** discloses a system wherein power consumption by I/O ports of a computer is improved by keeping the I/O port in an OFF state until an I/O operation requiring actual data transfer is encountered. When an I/O operation requiring actual data transfer is encountered, then the appropriate port is powered up (see, e.g., column 2, lines 12-19).

As discussed in detail below, the rejection under §103 is respectfully traversed because the Office action has not established a *prima facie* case of obviousness.

More specifically, it is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness and, as such, the rejection of claims 1-18 should be withdrawn, because (1) all the claim limitations are not taught or suggested by the cited prior art; (2) the Examiner has not provided proper motivation or incentive for combining the references; and (3) the Examiner has not considered all claim limitations in rejecting the claims.

As set forth in the Manual of Patent Examining Procedure (MPEP), Eighth Edition, Revision 2, May 2004, §2143.03 “To establish *prima facie* obviousness of a claimed invention, ***all the claim limitations*** must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Further, for a *prima facie* case of obviousness to exist, there must be “some objective teaching in the prior art or . . . knowledge generally available to one of ordinary skill in the art [that] would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Moreover, under §103, the Examiner is expected to



*provide a reason* why one of ordinary skill in the art would have been led to modify or combine the references to arrive at the claimed invention. *Uniroyal, Inc. v. Rudkin Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

Finally, “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

*All the claim limitations are not taught or suggested by the cited prior art*

Using claim 1 as exemplary, neither **Johnson et al.** nor **Pearce** disclose or suggest the claimed “power control unit that changes a power mode of the information processor from a power-saving mode to a normal power mode *when the receiving unit receives the remote control request*, and changes the power mode from the normal power mode to the power-saving mode *when the setting of the remote control data to the apparatus to be remote controlled is complete*” [emphasis added]. The cited references also do not disclose or suggest similar features recited in independent claims 4, 7, 10, 13 and 16 (i.e., “shifting a power mode ...to a normal mode...” and “shifting a power mode ... to the power saving mode...” recited in claims 4 and 7, etc.).

The Examiner recognizes that **Johnson et al.** do not disclose or suggest the power control unit recited in claim 1 (and similar features recited in claims 4, 7, 10, 13 and 16). The Examiner asserts that **Pearce** discloses the features missing from **Johnson et al.** However, **Pearce** does not disclose or suggest the *claimed* power control unit (and similar features recited in



independent claims 4, 7, 10, 13 and 16). Further, the Examiner does not point out where **Pearce** discloses the features missing from **Johnson et al.**

Specifically, the Office Action simply asserts that “Pearce states that the importance of power conservation is known in the art” and that “One well known way of achieving power conservation is shutting down parts of a computer which are not being used.”

However, unlike **Pearce**, the *claimed* invention defines a power control unit that changes from a power-saving mode to a normal power mode based on when a gateway card receiving unit receives a remote control request from a remote control device. Further, unlike **Pearce**, the *claimed* invention changes from a normal power mode to the power-saving mode based on when the setting of the remote control data to the remote control apparatus is complete.

Although **Pearce** generally teaches that shutting down parts of a computer that are not being used can be used to reduce power consumption, and specifically teaches that power consumption by I/O ports of a computer is improved by keeping the I/O port in an OFF state until an I/O operation requiring actual data transfer is encountered, as discussed above, **Pearce** does not disclose or suggest the type of power saving unit recited in claim 1 (and similar features in claims 4, 7, 10, 13 and 16).

As noted above, to establish *prima facie* obviousness of a claimed invention, *all the claim limitations* must be taught or suggested by the prior art. Neither **Johnson et al.** nor **Pearce** disclose or suggest the power saving unit recited in claim 1 (and similar features in claims 4, 7, 10, 13 and 16).



Therefore, it is respectfully submitted that the rejections under §103 are improper and should be withdrawn for at least the above reasons.

*The Examiner has not provided proper motivation or incentive for combining the references*

As noted above, Further, for a *prima facie* case of obviousness to exist, there must be “some objective teaching in the prior art or . . . knowledge generally available to one of ordinary skill in the art [that] would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Moreover, under §103, the Examiner is expected to ***provide a reason*** why one of ordinary skill in the art would have been led to modify or combine the references to arrive at the claimed invention. *Uniroyal, Inc. v. Rudkin Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

The only reason provided in the Office Action for combining or modifying the references is “Operating the information processor in a power-saving mode when it is not being used reduces unnecessary power consumption [Pearce, column 1, lines 54-58]” (see, e.g., Office Action, page 3, lines 10-11).

First, column 1, lines 54-58 of **Pearce** does not teach operating an information processor in a power-saving mode. Column 1, lines 54-58 of **Pearce** teaches placing the display screen or hard disk to a lower power standby state, but does not teach operating an information processor, as claimed, in a lower power standby state.



Second, it is submitted that if the general teaching of shutting down parts of a computer when they are not being used to save power was considered adequate motivation for combining **Pearce** with the **Johnson et al.** reference, then the **Pearce** reference would be properly combinable with every computer or electronic device.

Third, it is submitted that none of the references provide the requisite suggestion, teaching or motivation for modifying the **Johnson et al.** system to incorporate a power saving unit or operation, as claimed. At best, **Pearce** provides a general teaching of placing a display and a hard disk in a standby state. It is submitted that this teaching in no way suggests modifying the **Johnson et al.** monitoring and control system, *which completely lacks any teaching or suggestion of a power saving function*, to include the claimed power saving unit or operation.

Thus, it is respectfully submitted that the Office Action has used the inventors' disclosure as a blueprint for piecing the prior art together to defeat patentability – the essence of hindsight. Accordingly, it is submitted that the rejections under §103 are improper and should be withdrawn for these additional reasons.

*The Examiner has not considered all claim limitations in rejecting the claims*

As noted above, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Again, using claim 1 as an example, claim 1 specifically recites "a power control unit that changes a power mode of the information processor from a power-saving mode to a normal



power mode *when the receiving unit receives the remote control request*, and changes the power mode from the normal power mode to the power-saving mode *when the setting of the remote control data to the apparatus to be remote controlled is complete*” [emphasis added].

It is submitted that the highlighted portions in the passage above are indeed part of the claimed elements that must be considered in judging the patentability of the claim. However, the Office Action does not address where these elements are disclosed in the references.

Moreover, it is noted that it is improper to judge the obviousness of the “idea” behind the invention. “Reducing a claimed invention to an ‘idea,’ and then determining patentability of that ‘idea’ is error. Analysis properly begins with the claims, for they measure and define the invention.” *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984).

It is submitted that the rejection under §103 reduces the differences between the claimed invention and **Johnson et al.** to the idea of operating in a power saving mode. However, as noted above, reducing the differences between the **Johnson et al.** reference and the claimed invention to an idea does not properly consider all words in the claims.

Accordingly, it is submitted that the rejections under §103 are improper and should be withdrawn for this additional reason.

In view of the above remarks, it is submitted that independent claims 1, , 4, 7, 10, 13 and 16, and claims 3, 6, 9, 12, 15 and 18 which depend therefrom, patentably distinguish over the combination of **Johnson et al.** in view of **Pearce**.



Further, it is submitted that claims dependent 2, 5, 8, 11, 14 and 17 patentably distinguish over **Johnson et al.**, **Pearce** and **Hilt** for the same reasons as the independent claims from which they depend.

**New claims**

New claims 19 and 20 have been added by the present Amendment. New claim 19 depends from claim 2 and new claim 20 depends from claim 11. It is submitted that new claims 19 and 20 are allowable for the same reasons as the independent claims from which they depend.

**CONCLUSION**

In view of the foregoing amendments and accompanying remarks, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.



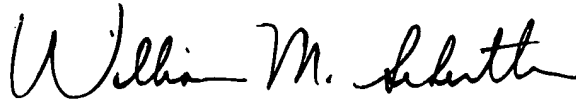
Application No. 10/658,341  
Art Unit: 2116

Amendment under 37 C.F.R. §1.111  
Attorney Docket No.: 031103

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**

A handwritten signature in black ink, appearing to read "William M. Schertler". The signature is fluid and cursive, with the first name "William" and last name "Schertler" being clearly legible.

William M. Schertler  
Attorney for Applicants  
Registration No. 35,348  
Telephone: (202) 822-1100  
Facsimile: (202) 822-1111

WMS/dlt